

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1, 3-14, 16-59, 61-72, and 74-116 are presently active in this case, Claims 1, 14, 30, 45, 59, 72, 88, and 103 having been amended by way of the present Amendment. Care has been taken such that no new matter has been entered. (See, e.g., page 8, lines 24-26.)

The Applicant wants to thank Examiner Dustin Nguyen for the courtesies extended to Applicant's representative, Christopher Ward, during the personal interview conducted on August 3, 2006.

In the outstanding Official Action, Claims 30-58 and 88-116 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the Official Action suggests that the subject matter of Claims 30, 45, 88, and 103 are not commensurate with the discussion in the paragraph beginning on page 12, line 8. This paragraph has been amended to correct an error noted therein and to thereby make the discussion commensurate with the claims. As agreed during the interview, the amendment to the specification overcomes the indefiniteness rejection, and therefore the Applicant respectfully requests the withdrawal of the indefiniteness rejection.

Claims 1-3, 7-14, 16, 19, 20, 23-29, 59, 61, 65-72, 74, 77, 78, and 81-87 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al. (U.S. App. Pub. No. 2002/0056118) in view of Wiser et al. (U.S. Patent No. 6,330,675). Claims 4-6, 17, 18, 21,

Application Serial No.: 09/764,270  
Reply to Office Action dated May 31, 2006

22, 30-35, 37-49, 51-58, 62-64, 75, 76, 79, 80, 88-93, 95-107, and 109-116 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al. in view of Wiser et al. and Srinivasan (U.S. Patent No. 6,460,076). Claims 36, 50, 94, and 108 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al. in view of Wiser et al., Srinivasan and further in view of Allen (U.S. Patent No. 5,794,217). For the reasons discussed below, the Applicant requests the withdrawal of the obviousness rejections.

The basic requirements for establishing a *prima facie* case of obviousness as set forth in MPEP 2143 include (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the reference (or references when combined) must teach or suggest all of the claim limitations. The Applicant submits that a *prima facie* case of obviousness cannot be established in the present case because the cited references, either when taken singularly or in combination, fail to teach or suggest all of the limitations recited in the pending claims.

Claim 1 recites a method comprising, among other features, transmitting the information from the network to the removable medium without writing any of the information to an intermediate storage device when the determining step determines that the device is an appropriate device for writing to the removable medium. Claim 14 recites a method comprising, among other features, writing the information received from the network to the removable medium using the device, without writing any of the information to an intermediate storage device when it is determined that the device is an appropriate device for

writing to the removable medium. Claim 30 recites a method comprising, among other features, writing the second importance information received from the network to a storage medium which is different from the hard disk drive, without writing any of the second importance information to the hard disk drive when a device configured to write to the storage medium does satisfy predetermined criteria including a capability to deal with an interrupted or non-steady data flow. Claim 45 recites a method comprising, among other features, transmitting the second importance information from the network to a storage medium of the remote computer which is different from the hard disk drive, without writing any of the second importance information to the hard disk drive when a device configured to write to the storage medium does satisfy predetermined criteria including a capability to deal with an interrupted or non-steady data flow. Claim 59 recites a system comprising, among other features, means for transmitting the information from the network to the recordable medium without writing any of the information to an intermediate storage device when the means for determining determines that the device is an appropriate device for writing to the removable medium. Claim 72 recites a system comprising, among other features, means for writing the information received from the network to the removable medium using the device, without writing any of the information to an intermediate storage device when it is determined that the device is an appropriate device for writing to the removable medium. Claim 88 recites a system comprising, among other features, means for writing the second importance information received from the network to a storage medium which is different from the hard disk drive, without writing any of the second importance information to the hard disk drive when a device configured to write to the storage medium does satisfy

predetermined criteria including a capability to deal with an interrupted or non-steady data flow. Claim 103 recites a system comprising, among other features, means for transmitting the second importance information from the network to a storage medium of the remote computer which is different from the hard disk drive, without writing any of the second importance information to the hard disk drive when a device configured to write to the storage medium does satisfy predetermined criteria including a capability to deal with an interrupted or non-steady data flow. The cited references, either when taken singularly or in combination, fail to teach or suggest the above limitations.

The Official Action acknowledges that the Hunter et al. reference fails to disclose the above limitations. (See, e.g. page 3, last line, through page 4, line 10; page 7, items 14, 18, and 20; page 9, item 29; page 11, item 42; page 12, item 52; and page 13, item 59.) The Hunter et al. reference does not disclose transmitting the information from the network to the removable medium without writing the information to an intermediate storage device when the device is appropriate, and when the device is not appropriate then transmitting the information to an intermediate storage device to store the information followed by reading the information from the intermediate storage device and writing the information to the removable medium using the device. The Hunter et al. reference does not disclose or even suggest such features.

The Official Action cites the Wiser et al. reference to supplement the teachings of the Hunter et al. reference. The Official Action cites to column 8, lines 7-19, of the Wiser et al. reference for the above features, which are clearly missing from the teachings of the Hunter et al. reference. As discussed during the personal interview, column 8, lines 6-19, of the

Wiser et al. reference discusses an embodiment of the distribution device (106). However, as noted during the interview, the distribution device (106) is only one part of the overall customer's system (112) described in the Wiser et al. reference and depicted in Figure 1 thereof.

Figure 1 of the Wiser et al. reference indicates that all of the data coming from a remote storage medium (102) enters the customer's system (112) through a local storage medium (104) before it is transmitted to the distribution device (106). Therefore, as is shown in Figure 8, which is the subject of discussion in column 8, lines 6-19, the data received at the distribution device (106) is actually being received from the local storage medium (104) of the customer's system (112). Column 3, lines 61-62, indicates that the local storage medium (104) is in fact the hard drive on the customer's home computer. Thus, the Wiser et al. reference clearly does not disclose transmitting information from a network to a removable medium without writing the information to an intermediate storage device under any scenario described therein, since in the Wiser et al. reference data transmitted from the remote storage medium is directly received by the local storage medium (104), i.e. the hard drive of the customer's home computer, before it is transferred to the distribution device or any other component of the customer's system.

Thus, the Applicant submits that the combined cited references fail to disclose transmitting information from a network to a removable medium without writing any of the information to an intermediate storage device in the manner recited in Claim 1, writing information received from a network to a removable medium using a device, without writing any of the information to an intermediate storage device in the manner recited in Claim 14,

means for transmitting information from a network to a recordable medium without writing any of the information to an intermediate storage device in the manner recited in Claim 59, or means for writing information received from a network to a removable medium using a device, without writing any of the information to an intermediate storage device in the manner recited in Claim 72.

Thus, the Applicant requests the withdrawal of the obviousness rejections of independent Claims 1, 14, 59, and 72 and the claims that depend therefrom.

The Official Action further cites the Srinivasan reference in the obviousness rejections of independent Claims 30, 45, 88, and 103. The Srinivasan reference is cited for the teaching of predetermined criteria of a model number or make of the recording device. The Srinivasan reference fails to supplement the deficiencies noted above in the combined teachings of the Hunter et al. and Wiser et al. references. The Applicant notes that the Srinivasan reference describes a user interface (18), which is described as a personal computer (column 4, lines 1-3), that includes memory (34) within which is stored information that is downloaded from the web for later transfer to the memory recorder (column 4, lines 41-60).

Thus, the Applicant submits that the combined cited references fail to disclose writing second importance information received from a network to a storage medium which is different from the hard disk drive, without writing any of the second importance information to the hard disk drive in the manner recited in Claim 30, transmitting second importance information from a network to a storage medium of a remote computer which is different from the hard disk drive, without writing any of the second importance information

Application Serial No.: 09/764,270  
Reply to Office Action dated May 31, 2006

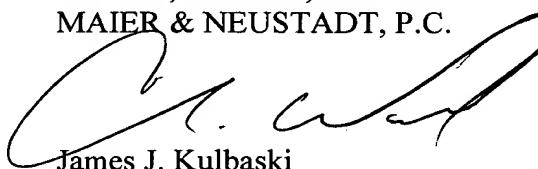
to the hard disk drive in the manner recited in Claim 45, means for writing second importance information received from a network to a storage medium which is different from the hard disk drive, without writing any of the second importance information to the hard disk drive in the manner recited in Claim 88, or means for transmitting second importance information from a network to a storage medium of the remote computer which is different from the hard disk drive, without writing any of the second importance information to the hard disk drive in the manner recited in Claim 103.

Thus, the Applicant requests the withdrawal of the obviousness rejections of independent Claims 30, 45, 88, and 103 and the claims that depend therefrom.

Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



James J. Kulbaski  
Registration No. 34,648  
Attorney of Record

Christopher D. Ward  
Registration No. 41,367

Customer Number

**22850**

Tel. (703) 413-3000  
Fax. (703) 413-2220  
(OSMMN 10/01)

JJK:CDW:brf  
I:\atty\cdw\19xxxx\199527US2X\am5.doc